DETAILED ACTION

Status of the Application

1. Receipt of Applicant's Remarks and Arguments filed on 28th Feb 2008 is acknowledged. In view of applicants arguments the previous 102(b) rejection has been withdrawn. However, the arguments for the 103(a) rejection are not found persuasive and as such, the following rejection has been maintained.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-21 are again rejected under 35 U.S.C. 103(a) as being unpatentable over **Malthe-Sorenssen** (US 5,948,940) for the reasons of record in the Office Action dated 10/29/07.

Response to Arguments

5. Applicant's arguments filed on 28th Feb 2008 have been fully considered but they are not persuasive.

The thrust of applicants' arguments is that **Malthe-Sorenssen** fails to teach or suggest applicants' 1-methoxy-2-propanol as a reaction solvent in their process for iohexol manufacture and applicants allege that even though the solvents in question only differ by one carbon, they act very differently.

The examiner does not find these arguments persuasive. The examiner knew that the prior art did not disclose applicants' solvent. However, **Malthe-Sorenssen** clearly suggests to one having ordinary skill in the art the use of similar solvents. After all it is routine for skilled artisan to use art recognized alternative solvents. So, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made, to use 1-methoxy-2-propanol in the **Malthe-Sorenssen** process with a reasonable expectation of success.

Applicants argue how the cited reference differ from the instant invention, but the obviousness test under 35 U.S.C. 103 is whether the invention would have been obvious in view of the prior art taken as a whole. In re Metcalf et al. 157 U.S.P.Q. 423.

Applicants allege that even though the solvents in question only differ by one carbon, they act very differently and attempt to demonstrate so by way of comparative data shown in the table 1 and 2. However, results in tables 1 and 2, such as yield/purity of the product and the amount of other impurities, are not significantly different from the closest prior art.

So, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made, to use 1-methoxy-2-propanol in view of **Malthe-Sorenssen**, with a reasonable expectation of success of making the final product in the prior art.

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136 (a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no even, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sudhakar Katakam whose telephone number is 571-272-9929. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S. Katakam

/Elvis O. Price/

Primary Examiner, Art Unit 1621